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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,056	12/04/2000	Pascal Arnaud	200436US0	3932

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OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER

WILLIS, MICHAEL A

ART UNIT PAPER NUMBER

1619

DATE MAILED: 01/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,056

Applicant(s)

ARNAUD, PASCAL

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's response of 7 November 2001 is entered.

Election/Restrictions

2. The requirement for restriction is withdrawn. Applicant's traversal of the restriction requirement is found persuasive. Claims 1-44 are examined.
3. Applicant's election with traverse of isododecane, phenyltrimethicone, and diglyceryl diisostearate as the elected species in Paper No. 8 is acknowledged. The traversal is on the grounds that the Office has not provided sufficient reasons to conclude that the species are indeed patentably distinct. As stated previously, if applicant traverses on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. It is the position of the examiner that, for example, in claim 6, compounds with carboxyl groups would not anticipate or render obvious 5-membered nitrogen containing rings.

Applicant further asserts that the claims do not present an unreasonable number of species. This is not found persuasive because the number of compounds encompassed by the phrase "volatile hydrocarbon-based solvent" is in the hundreds, if not thousands. When combined with the other components of the composition, the non-volatile silicon and the non-volatile hydrocarbon-based oil as well as further additives, the number of claimed compositions is vast.

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4. The requirement for election of species is still deemed proper and is therefore made FINAL. Claims 1-44 are examined as they read on isododecane, phenyltrimethicone, and diglyceryl diisostearate.

Specification

5. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. See page 8, lines 9-12 and page 10, lines 14-17. The material would appear to be essential as it describes embodiments of the invention rather than background material. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 5 and 6 are confusing and inconsistent due to the phrase "at least one nonionic polar group selected from the group consisting of -COOH". It is not clear to the examiner that a carboxylic acid group is nonionic. Clarification is requested. The claims are additionally confusing in that the elected species of hydrocarbon-based oil does not appear to read on these claims, as it contains -COOR groups rather than -COOH groups. Furthermore, the claims are confusing because the nitrogen in the figure is drawn with only two bonds while it is customary to draw nitrogen with three bonds.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walling et al (US Pat. 5,948,394) in view of Jakobson et al (US Pat. 5,093,043).

Walling teaches transfer-resistant lip compositions. The compositions resist transfer upon subjecting the wearer to routine or daily activities. The compositions are in the form of lipstick (see abstract). The compositions comprise lipophilic materials and a variety of other components (see claims 1-6). Walling teaches that a preferred volatile hydrocarbon fluid for use in the invention is isododecane (see col. 4, lines 1-16; and col. 6, line 15 through col. 7, line 45; examples 1-6). Walling further teaches that a particularly useful silicone fluid for use in the invention is available as the 556 series from Dow Corning (see col. 5, lines 3-9). DC 556 is a tradename for phenyltrimethicone. Walling further teaches that phenyltrimethicone is a most preferred fluid for the invention (see col. 5, lines 17-20). While the reference is silent regarding % by weight of phenyltrimethicone, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955).

Examples 1-6 are further comprised of wax and pigments. Additionally, examples 1-4 and 6 contain polyglycerol diisostearate. The reference lacks diglyceryl diisostearate.

Jakobson teaches a process for preparing nonionic surfactants. The reference relates to the use of certain nonionic polyglycerol fatty acid ester surfactants as additives or solvents for skin protection agents and skin care oils and for cosmetic

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formulations (see col. 3, line 47 through col. 4, line 11). Jakobson teaches that diglycerol di(fatty acid esters) have improved properties as compared to polyglycerol esters (see col. 4, lines 54-64). Jakobson specifically compares diglycerol diisostearate with commercial polyglycerol diisostearate (see col. 5, lines 17-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Walling by the substitution of diglycerol diisostearate for polyglycerol diisostearate as taught by Jakobson in order to benefit from the improved properties of diglycerol diisostearate as taught by Jakobson.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Agostini et al (US Pat. 6,024,969) discloses compositions containing a volatile oil and phenylated silicone oil, in a fatty phase, as a cosmetic composition for avoiding transfer to other surfaces. Jacks et al (US Pat. 5,690,918) discloses solvent-based non-drying lipstick. Mougin et al (US Pat. 5,851,517) discloses compositions comprising isododecane and diglyceryl diisostearate (see Example 11) and further teaches the use of phenyltrimethicone. De la Poterie et al (US Pat. 6,254,876) discloses transfer-resistant cosmetic compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on Mon. to Fri. from 9 a.m. to 5:30 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

January 16, 2002



MICHAEL G. HARTLEY
PRIMARY EXAMINER